2/21/02

Paper No. 10
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re James Raymond Bevan

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Serial No. 75/810,317

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James Raymond Bevan, pro se.[1]

Dinisa Hardley, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

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Before Chapman, Rogers and Drost, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On October 20, 1999, James Raymond Bevan (a Canadian citizen, residing in Pennsylvania) filed an application to register the mark MAD NOMAD on the Principal Register for services identified, as amended, as "entertainment services in the nature of live performances by a musical group" in International Class 41. The application is based on

[1] An attorney filed the response to the first Office action, and was entered as counsel of record for applicant. Applicant signed the notice of appeal, and submitted his own brief on appeal. Thereafter, applicant filed a statement that the attorney no longer represented him, and requested that correspondence be sent directly to applicant.

applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with his identified services, so resembles the mark NOMAD, which is registered for "pre-recorded audio cassettes and compact discs featuring music" in International Class 9, and "entertainment services in the nature of the production and presentation of musical concerts" in International Class 41,[2] as to be likely to cause confusion, or to cause mistake, or to deceive.

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have briefed the issue before us, and an oral hearing was not requested.

Before turning to the merits, we must address an evidentiary matter. In his brief on appeal (unnumbered pages 3, 4 and 5), applicant, for the first time, referred to several third-party marks identifying them by application serial number. The Examining Attorney objected to the evidence as both untimely and in an improper format

[2] Registration No. 1,994,177, issued August 13, 1996.

(that is, merely referenced in a typed list rather than introduced by filing photocopies of the registrations). Even if we assume all of the marks in these third-party applications are now registered, the Board cannot consider them, because this evidence is untimely and not in the proper format. Specifically, on the timeliness matter, the record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal will ordinarily be given no consideration by the Board. See Trademark Rule 2.142(d). Moreover, mere typed listings of third-party registrations are not an appropriate way to enter such material into the record, and the Board does not take judicial notice of registrations in the USPTO. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); Cities Service Company v. WMF of America, Inc., 199 USPQ 493 (TTAB 1978); and In re Duofold Inc., 184 USPQ 638 (TTAB 1974). Accordingly, applicant's references to third-party marks have not been considered in making our decision.[3]

[3] We note that even if applicant had timely and properly submitted the evidence of third-party registrations, it would not be persuasive of a different result in this case. As often noted by the Board, each case must decided on its own merits. We are not privy to the records of the third-party registration files, and moreover, the determination of registrability of those particular marks by Trademark Examining Attorneys cannot control the merits in the case now before us. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even

We now turn to the merits of the appeal, and we affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); and In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999).

The Examining Attorney argues that applicant's mere addition of one word to an already registered mark does not obviate the likelihood of confusion; that the involved marks are similar in sound, appearance, and commercial impression; and that applicant's services (live performances by a musical group) are closely related to registrant's goods (cassettes and compact discs featuring music) and services (producing and presenting musical concerts).

Applicant urges reversal on the basis that confusion is not likely in this case because of "the extreme

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if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court.") See also, In re Dos Padres Inc., 49 USPQ2d 1860, 1862 (TTAB 1998).

improbability of the applicant's and the registrant's marks appearing together" (brief, unnumbered p. 2) as registrant is a small record company in North Carolina whereas applicant is a musical group appearing only in the Philadelphia area; that the addition of the word MAD to the word NOMAD creates a rhyme, as well as a different, balanced appearance, and connotes an implied contradiction (mad, no mad); and that the goods and services of registrant are different from the services of applicant in that applicant does not produce concerts and registrant is not a musical group.

We turn first to a consideration of the registrant's goods and services and applicant's services. It is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods and/or services. See In re Melville Corp., 18 USPQ2d

1386 (TTAB 1991); and In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

Of course, it has been repeatedly held that in determining the registrabilty of a mark, this Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, applicant's services, "entertainment services in the nature of live performances by a musical group," and registrant's "pre-recorded audio cassettes and compact discs featuring music" and "entertainment services in the nature of the production and presentation of musical concerts" are clearly complementary, closely related goods and services. The Examining Attorney submitted copies of several third-party registrations, which issued on the basis of use of the marks therein in commerce, to demonstrate the relationship between the involved goods and services, by showing in each instance that a single entity has adopted one mark for audio cassettes and compact discs and live musical performances.

Third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nevertheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods and/or services emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785 (TTAB 1993); and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467, 1470 footnote 6 (TTAB 1988).

There can be no doubt as to the close relationship between live performances by a musical group, the production and presentation of musical concerts, and the sale of compact discs and cassettes featuring music. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); Safety-Klean Corporation v. Dresser Industries, Inc., 518 F.2d 1399, 186 USPQ 476 (CCPA 1975); and Steelcase Inc. v. Steelcare Inc., 219 USPQ 433 (TTAB 1983).

Although applicant does not offer the service of producing musical concerts (and he has not applied for the mark for compact discs and cassettes), nonetheless, applicant’s involved entertainment services are commercially closely related to registrant’s entertainment

services and goods. The fact that applicant and registrant do not offer the same services (or goods) is not controlling. The salient question to be determined is not whether the services (and goods) of the parties are likely to be confused, but rather whether there is a likelihood that the public will be misled into the belief that the services originate from a common source. See The State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc., 190 USPQ 25, 30 (TTAB 1976).

Turning next to a consideration of the respective marks, it is well settled that marks must be considered in their entireties as to the similarities and dissimilarities thereof. The marks involved herein share the common word NOMAD, with applicant simply adding the word MAD thereto. This difference in the marks does not serve to distinguish the marks. We are not persuaded that because "mad" and "nomad" rhyme there is a different commercial impression created by the involved marks. See In re El Torito Restaurants Inc., 9 USPQ2d 2002 (TTAB 1988); and In re United States Shoe Corp., 229 USPQ 707 (TTAB 1985).

Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must

be based on the similarity of the general overall commercial impressions engendered by the involved marks. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980).

In this case, the addition of the word MAD does not serve to distinguish the marks. Purchasers are unlikely to remember the specific differences between the marks due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. That is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

In any event, purchasers familiar with registrant's services and goods sold under the registered mark NOMAD may, upon seeing applicant's mark MAD NOMAD on closely related services, assume that applicant's services come from the same source as registrant's services and goods, or are somehow sponsored by or approved by registrant.

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against applicant as the newcomer because the

newcomer has the opportunity of avoiding confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997).

Accordingly, because of the similarity of the parties' marks and the relatedness of the parties' goods and services, we find that there is a likelihood that the purchasing public would be confused when applicant uses MAD NOMAD as a mark for his services.

Decision: The refusal to register under Section 2(d) is affirmed.